

6

Docket No. GEN-T111XC3D2
Serial No. 09/901,484Remarks

Claims 50-53, 56-58, 60, 63, 64, 67-69, and 71-86 are pending in the subject application. Applicants gratefully acknowledge the Examiner's withdrawal of the rejection under 35 U.S.C. § 103(a) and (b). Applicants note that the disposition of claims on the Office Action Summary page did not include claim 69 as pending. By this Amendment, Applicants have amended claims 60, 73, 85, and 86 and canceled claims 50-53, 56-58, 63, 64, 67-69, 71, 72, and 74-84. Support for the amendments can be found throughout the subject specification and in the claims as originally filed (see, for example, page 23, line 29, of the as-filed specification). The specification and claims have been amended to correct an inadvertent typographical error. Namely, "5160" has been replaced with "35160". Support for the amendment can be found, for example, at page 23, line 29 of the as-filed specification which describes the biallelic marker (identified as 99-589-41) at position 35160 in SEQ ID NO: 179. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 60, 73, 85, and 86 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Applicants gratefully acknowledge the Examiner's indication that claims 60 and 73 are objected to but would be allowable if rewritten into independent form to include the limitations of any base and intervening claims. Applicants also gratefully acknowledge the Examiner's indication that claims 85 and 86 are allowed. By this Amendment, claims 60 and 73 have been amended to include the limitation of claims 50 and 71, respectively. Applicants respectfully submit that the amendments presented herein place the subject application in condition for allowance.

Claims 50-52, 56-58, 63, 64, 67, 68, 71, 72, and 74-84 are rejected under 35 U.S.C. §§ 102(a) and (b) as anticipated by Osoegawa *et al.* (1998) as evidenced by Genbank Accession No. AC009631, and an email from Pieter de Jong. Applicants respectfully assert that the Osoegawa *et al.* reference does not anticipate the claimed invention. However, by this Amendment, Applicants have canceled all the claims under this rejection. Thus, this rejection is moot. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102(a) and (b) is respectfully requested.

Claim 53 is rejected under 35 U.S.C. § 103(a) as obvious over Osoegawa *et al.* (1998) in view of Capecchi *et al.* (1989). The Office Action states that it would have been *prima facie* obvious

J:\GEN\T111XC3D2\Amend-Resp\Amd.after.rcc.2d.doc\DNB/sl

7

Docket No. GEN-T111XC3D2
Serial No. 09/901,484

to one of ordinary skill in the art to screen each of the sequences of Osoegawa *et al.* for functional activity using the homologous recombination method of Capecchi *et al.* Applicants respectfully assert that the cited references do not render the claimed invention obvious. Applicants have canceled claim 53, thereby rendering this rejection moot. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

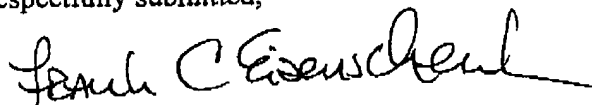
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



Frank C. Eisenschenk, Ph.D.

Patent Attorney

Registration No. 45,332

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: P.O. Box 142950
Gainesville, FL 32614-2950

FCE/sl

J:\AGENT\111XC3D2\Amend-Resp\Amd.after.rec.2d.doc\DNB/sl